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09/596,863	06/19/2000	Istvan Novak	5181-62800	7061

7590

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EXAMINER

LEE, BENNY T

ART UNIT

PAPER NUMBER

2817

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-15 and 17-30 rejected under 35 U.S.C. 103(a) as being unpatentable over Harada et al. U.S. Patent No. 6,198,362 in view of Roy et al. "ESR and ESL of Ceramic Capacitor Applied to Decoupling Applications" (cited by the applicant as B19) and Novak "Reducing Simultaneous Switching Noise and EMI on Ground/Power Planes by Dissipative Edge Termination" (cited by the applicant as B15) {all of record, for reasons of record}.

It should be noted with respect to the newly added limitations of claims 8 and 17 (i.e., less than or equal to the inductance of the electrical power distribution structure  $L_p$ ) that the  $L_p$  is defined as  $\mu_o \bullet h$ ; therefore, the rejections based on the mounted inductance being less than  $0.2 \bullet n \bullet \mu_o \bullet h$  also apply.

### *Response to Arguments*

Applicant's arguments filed 21 February 2003 have been fully considered but they are not persuasive.

The applicant argues that the mounted inductance being less than or equal to the  $L_p$  is not inherent. Moreover, it is argued that there is no teaching that such mounted inductance must have a value less than  $L_p$  to suppress electromagnetic waves.

This argument is not persuasive because it is the inherent property of the capacitor mounted on the board, which is the basis for determining the mounted inductance (i.e. that is the meaning of the adjective "mounted"). The inherency of the mounted inductance being less than or equal to the  $L_p$  or  $0.2 \cdot n \cdot \mu_o \cdot h$  is based on the fact that the Harada et al. reference discloses that the undesired wave radiated from the power supply is suppressed when the value of  $L_p$  is minimized, which is the requirement for the value of the mounted inductance (col. 7, lines 50-65 and figure 6). That is, the undesired electromagnetic wave would not be suppressed unless the mounted inductance is minimized to a value which is less than the limit recited in the claim (again see col. 7, lines 50-65). As noted in MPEP 2112, the express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Furthermore, MPEP 2112 states "once a reference teaching product appearing to be substantially identical is made the basis of a rejection, and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference".

*Allowable Subject Matter*

Claims 31-35 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

None of the cited references teaches a method involving making a determination of two different number of capacitors based on whether plane resonances are to be suppressed or not as recited in independent claim 31.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

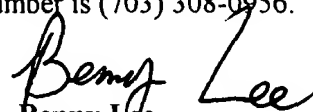
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benny Lee whose telephone number is (703) 308-4902.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Pascal can be reached on (703) 308-4909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular

communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
Benny Lee  
Primary Examiner  
Art Unit 2817

B. Lee  
May 2, 2003